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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,121	10/27/2003	Graham B. McCloy	SCH-00026-COA	6102

7590 05/26/2005

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EXAMINER

SEMBER, THOMAS M

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

8m

Office Action Summary	Application No. 10/695,121	Applicant(s) MCCLOY ET AL.	
	Examiner Thomas M. Sember	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>031004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The limitation of “a threaded faster for attaching the light module to the bezel” as claimed in claims 23 and 33 is not supported by the specification. On page 2, lines 6-9 applicant discloses a clip fastener for attaching the light module 40 to a bezel 28. Then applicant further discloses at lines 8-9 “Alternatively a threaded fastener 46 may can be inserted up through the bottom of the bezel 28 through boss 48 and into corresponding boss in housing 16”. This contradicts applicant’s claimed recitation that the threaded fastener attaches the light module to the bezel. It appears that the specification only supports that the threaded fastener attaches the bezel 28 to the housing 16, not the light module 40 to the bezel 28. See also figures 2-4.

Furthermore, in lines 8-9 the recitation of “Alternatively, a threaded fastener 46 **may can** be inserted up through the bottom of the bezel 28 through boss 48 and into corresponding boss in housing 16.” is idiomatically incorrect.

Appropriate correction is required

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "a threaded fastener for attaching the light module to the bezel" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claims 23 and 33 are objected to because of the following informalities: The limitation of "a threaded faster for attaching the light module to the bezel" as claimed in claims 23 and 33 is not supported by the specification. On page 2, lines 6-9 applicant first discloses a clip fastener for attaching the light module 40 to a bezel 28. Then applicant further discloses at lines 8-9 "Alternatively, a threaded fastener 46 may can be inserted up through the bottom of the bezel 28 through boss 48 and into corresponding boss in housing 16." This contradicts applicant's claimed recitation that the threaded fastener attaches the light module to the bezel. It appears that the specification only supports that the threaded fastener attaches the bezel 28 to the housing 16, not the light module 40 to the bezel 28. See also figures 2-4. Appropriate correction is required

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-40 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-31 and 41-66 of copending Application No. 10/495,105. Although the conflicting claims are not identical, they are not patentably distinct from each other because merely uses slightly different claim language to claim the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-22, 25-32 and 35-40 are rejected under 35 U.S.C. 102(b) as being anticipated by Pastrick et al '654. Pastrick et al '654 (particularly figure 22) discloses a mirror assembly for a vehicle comprising: a mirror housing 26,' a reflective element 28,' a backing assembly (42, 43, see figure 8) supported by the mirror housing, the backing assembly supporting the reflective element; a bezel 104 having a height for extending below the housing 26', formed as a separate element of and attached to a lower portion of the mirror housing 26', a portion of the bezel 104 including an opaque contoured surface portion extending from the lower portion of the mirror housing, the bezel having an opening 136 for projecting light through the lens 160, a light module 151 disposed

within the bezel, the light module 151 having a light source 152 for providing light to be projected through the lens 154; and a lens 154 formed in the opening, the light projecting through the lens 154. The bezel 104 is disposed generally beneath the backing assembly and the reflective element 28. The opening in the bezel 104 projects rearwardly. The light source 52 generates light to provide at least one of a turn signal light, an approach light, and a vehicle side marker light (can be used as all three, see columns 1-2 and entire specification). The light source assembly 151 has a reflective inner surface (not explicitly shown in figure 22 but explicitly taught in Pastrick et al's disclosure, see figure 8, reflective element 62) being shaped to direct a maximum amount of light emitted from the light source 152 to the lens 154. The lens 154 is operative to direct light through an arc extending at least 40 degrees (see column 1, lines 55-61,). Pastrick et al teaches the angle to be up to 45 degrees) rearwardly from approximately a line passing through the minor assembly and extending perpendicular to the longitudinal axis of the vehicle. The light source is operable to provide a signal visible through the light transmitting lens 154 to a rearward motor vehicle when activated. The light source 152 generates light to provide a vehicle approach light and wherein the lens of one of red, amber, and white (as taught in column 8, lines 29-56). The light source 152 generates light to provide a vehicle side marker light and wherein the lens is one of red, amber, and white (as taught in column 8, lines 29-56.) The bezel 140 is attached to the housing mirror housing via fastener 169.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pastrick et al '654 in view of Alonzo, Jr. et al. Pastrick et al '654 discloses the claimed invention except for the teaching of a threaded fastener for attaching light module to a bezel.

Pastrick et al '654 doesn't mention the type of fasteners used to hold the module to bezel 116, but does indicate at column 11, line 67-column 12, lines 1-4 that when the cover member 160 and optical surface engage with flange 146 to create a water-tight engagement.

Alonzo Jr. et al (figure 1) teaches a threaded fastener 16 for attaching lamp module 12 to bezel 14.

It would have been obvious to one skilled in the art at the time of applicant's invention to modify the light module of Pastrick et al so as to include a threaded fastener as taught by Alonzo, Jr. et al in order to provide an effective means for attaching the light module to the bezel.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pastrick et al '654 in view of Desmond et al. Pastrick et al '654 discloses the claimed invention except for the teaching of a threaded fastener for attaching the light module to a bezel.

Pastrick et al '654 doesn't mention the type of fasteners used to hold the module to bezel 116, but does indicate at column 11, line 67-column 12, lines 1-4 that when the cover member 160 and optical surface engage with flange 146 to create a water-tight engagement.


Desmond et al teaches a clip-type fastener 66 for attaching lamp module 40 to a bezel.

It would have been obvious to one skilled in the art at the time of applicant's invention to modify the light module of Pastrick et al so as to include a threaded fastener as taught by Desmond et al in order to provide an effective means for attaching the light module to the bezel.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Sember whose telephone number is 571-272-2381. The examiner can normally be reached on M-F 8 A.M- 5.30 p.m. first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 703-571-2878. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thomas M Sember
Primary Examiner
Art Unit 2875
